

## REMARKS/ARGUMENTS

Claims 33, 38-40 and 44-54 are pending in the instant application.

Applicants note and appreciate the Examiner's statement that claims 33, 38-40, and 44-47 are allowable.

The remaining rejections of claims 48-54 under 35 U.S.C. §112, first paragraph, and 35 U.S.C. §102 are addressed below.

### **I. Information Disclosure Statement**

The Examiner states that the Information Disclosure Statements filed on September 12, 2002 and November 6, 2002 do not give sufficient identifying information because they do not identify each reference by author and publication date. Applicants respectfully remind the Examiner that in their Response filed September 9, 2004, Applicants filed an Information Disclosure Statement listing each reference separately and including authors/inventors, relevant accession numbers and publication dates for each individual sequence found in the two previously submitted BLAST searches. References 1-10 are the database entries for the polypeptide sequences found in the BLASTP 2.2.1 search, while references 11-19 are the database entries for the nucleic acid sequences found in the BLASTN 2.2.1 search. These references are intended to replace or supplement the polypeptide BLASTP 2.2.1 and nucleic acid BLASTN 2.2.1 search listings. The Examiner initialed these references as having been considered on December 7, 2004. Accordingly, Applicants respectfully request that the information listed be considered by the Examiner in its entirety and made of record in the instant application.

## II. Priority

Applicants thank the Examiner for acknowledging that Claims 33, 38-40, and 44-47 are afforded the benefit of the filing date of U.S. Provisional Patent Application Serial No. 60/162,506, which was filed October 29, 1999.

The Examiner asserts, however, that Claims 48-54 do not get the benefit of the effective filing date of October 29, 1999, allegedly "because the parent application does not disclose that fragments of the nucleic acid of SEQ ID NO:76 are amplified in lung or colon tumors." (Page 3 of the instant Office Action).

Applicants respectfully point out that the Examiner has acknowledged that "[t]he instant specification as well as the parent application discloses that the full length sequence of SEQ ID NO:76 is amplified in lung and colon tumors compared to normal controls. Therefore, a fragment of the nucleic acid of SEQ ID NO:76 that consists of 20 to 100 nucleotides would be useful as a probe." (Page 4 of the instant Office Action). Thus the Examiner has acknowledged that one of skill in the art would understand how to use 20 to 100 nucleotide fragments of SEQ ID NO:76, based upon the disclosure of the priority application. The fragments recited in Claims 48-54 are all fragments of SEQ ID NO:76, or complements thereof, which are also clearly useful as probes. The claims do not recite any fragments that are not derived from SEQ ID NO:76, or complements thereof. Thus one of skill in the art would understand how to use any and all of the claimed fragments as probes to detect the expression of SEQ ID NO:76, based upon the disclosure of the priority application. Accordingly, Claims 48-54 are entitled to the effective filing date of 29 October 1999, the filing date of the priority application U.S. Provisional Patent Application Serial No. 60/162,506.

## III. Claim Rejections Under 35 U.S.C. §112, First Paragraph (Enablement)

Claims 48-54 remain rejected under 35 U.S.C. §112, first paragraph as allegedly lacking enablement. The Examiner asserts that "the instant specification is enabling for an isolated nucleic acid that consists of 20-100 nucleotides of SEQ ID NO:76, but does not enable for a fragment that consists of 20-100 nucleotides that hybridizes to SEQ ID NO:76, because non-identical primers are not useful as probes." (Pages 4-5 of the instant Office Action).

Applicants respectfully point out that Claims 48 (and as a consequence, those claims dependent from the same) recites "An isolated nucleic acid molecule consisting of an at least 20 nucleotides fragment of the nucleic acid sequence of SEQ ID NO:76, or a complement thereof, that specifically hybridizes under stringent conditions to ...." Therefore, Claims 48-54 do not claim any non-identical fragments, but only fragments of SEQ ID NO:76, or complements thereof. As recited in the claims, these fragments also have the property of hybridizing to SEQ ID NO:76. The recited fragments which hybridize to SEQ ID NO:76 are not a separate category of fragments. The only fragments recited in Claims 48-54 are fragments of SEQ ID NO:76, or complements thereof.

The Examiner has acknowledged that "a fragment of SEQ ID NO:76 that consists of 20 to 100 nucleotides would be useful as a probe." (Page 4 of the instant Office Action). Complements of these fragments would also clearly be useful as probes. Thus one of ordinary skill in the art would understand how to use the fragments of Claims 48-54, as probes to detect the expression of SEQ ID NO:76.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the present rejections under 35 U.S.C. §112, first paragraph.

#### **IV. Claim Rejections Under 35 U.S.C. §102**

Claims 48-54 remain rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Baker *et al.*, WO 200012708, published on March 9, 2000, or by Strausberg (Accession No. BE782249, October 20, 2000) or by Ansorge *et al.* (Accession No. AL050202, February 18, 2000).

Applicants respectfully submit that, as discussed above in the section concerning priority, Claims 48-54 are entitled to the effective filing date of 29 October 1999, the filing date of the priority application U.S. Provisional Patent Application Serial No. 60/162,506. The Examiner has acknowledged that "[t]he instant specification as well as the parent application discloses that the full length sequence of SEQ ID NO:76 is amplified in lung and colon tumors compared to normal controls. Therefore, a fragment of the nucleic acid of SEQ ID NO:76 that consists of 20 to 100 nucleotides would be useful as a probe." (Page 4 of the instant Office Action).

Thus the Examiner has acknowledged that one of skill in the art would understand how to use 20 to 100 nucleotide fragments of SEQ ID NO:76, based upon the disclosure of the priority application. Claims 48-54 do not recite any fragments that are not derived from SEQ ID NO:76, or complements thereof. Thus one of skill in the art would understand how to use any and all of the claimed fragments as probes to detect the expression of SEQ ID NO:76, based upon the disclosure of the priority application. Accordingly, Claims 48-54 are entitled to the effective filing date of 29 October 1999, the filing date of the priority application U.S. Provisional Patent Application Serial No. 60/162,506.

Hence, Strausberg is not prior art under 102(a) since its filing date is after the effective priority date of this application. Similarly, Ansorge *et al.* is not prior art under 102(a) since its filing date is after the effective priority date of this application. Furthermore, Baker *et al.* is not prior art under 102(a) since its filing date is after the effective priority date of this application.

Accordingly, Applicants respectfully request that rejections under 35 U.S.C. §102(a) to Claims 48-54 be withdrawn.

## CONCLUSION

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should there be any further issues outstanding, the Examiner is invited to contact the undersigned attorney at the telephone number shown below.

Applicants expressly reserve the right to pursue any canceled subject matter in subsequent continuation, divisional or continuation-in-part applications.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39780-2830 P1C45).

Respectfully submitted,

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